

REMARKS/ARGUMENTS

This is in response to the Office Action of November 1, 2006. Claims 91–148 are pending in the present application, prior to entry of this amendment. (Claims 1–90 were canceled in previous amendments.)

Claims 114–148 were considered by the examiner as withdrawn from consideration as directed to non-elected inventions. Only claims 91–113 were formally examined and were rejected. However, and as noted below, the examiner is requested to reconsider the restriction and include claims 114–148.

New claims 149–169 are presented for entry and consideration. Of these claims, only claim 149 is independent. Independent claim presents the subject matter of objected-to claims 109 and 106 in independent form and should be allowable.

The independent claims 91, 114, and 131 have been amended to clarify certain aspects of the invention relating to the address book database, as maintained on behalf of a first party. Certain dependent claims have been amended to correct dependency references and antecedent basis issues.

Regarding the Restriction Requirement

The examiner acknowledged the applicant's election with traverse of claims 91–113. The examiner is respectfully requested to reconsider and withdraw the restriction in view of the following points.

The examiner stated in the Office Action that should applicant traverse on the ground that the inventions (of the three independent claim sets under claim 91, 114, and 131), applicant should submit evidence or identify evidence now of record showing the invention(s) to be obvious variants or clearly admit on the record that this is the case.

In this regard, applicant points out the following aspects of claims 91, 114, and 131: All of such claims are directed to computer-implemented methods for effecting online payment and *include a number of common elements that establish patentability* over the art of record. Claim 91 is directed to a “money transfer” between a first party and a second party (i.e. making an online payment and/or requesting an online payment). Claim 114 is directed to making an online

payment to a second party, plus certain security information elements. Claim 131 directed to requesting an online payment from a second party. All of such claims have been amended (as discussed fully below) to emphasize certain features and aspects believed to define over the references. All of such claims include at least these common limitations (as summarized for brevity):

- 1) maintaining the address book database at the payment enabler system on behalf of a first party,
- 2) in response to selection of an entry in the address book database for a transaction, retrieving the email address of the selected (second) party,
- 3) accessing the registered users database and determining whether the selected second party already has a record in the registered users database,
- 4) if not, sending the selected second party a registration invitation email, and
- 5) conducting a user registration process.

Claim 91 does not specify whether the transaction is a payment from or to the first party, it just recites a “money transfer.” Claim 114 includes further limitations of requesting security information, and is for making a payment from the first party to the second party. Claim 131 is specifically directed to the first party requesting a payment from the second party, otherwise is very similar to claim 91.

For the record, therefore, it is submitted that either all claims should define over the art for the reasons as set forth below, and should stand or fall together. The applicant admits that at claims 92 and 131 are obvious variants. Applicant further asserts that claim 114 contains sufficient common limitations so that it should be found patentable together with claims 92 and 131, but contains certain further limitations that do not necessarily make it an obvious variant. Nonetheless, the common limitations are such that it makes no sense to divide this (or any) claim out, and applicant requests that the restriction be withdrawn – for purposes of allowance or for purposes of appeal.

Information Disclosure Statement

The examiner indicated that certain items in the filed Information Disclosure Statements had certain issues. With respect to Items 84, 88, and 93, which were indicated as having word processing (typographic errors), it is believed that the examiner has all the relevant information from those documents to consider them fully; there is no further information available (e.g. the actual documents have 3 pages instead of 2 as stated in the IDS). The examiner's attention to and mention of these issues is appreciated, and the applicant apologizes for any inconvenience, but such errors are not believed to affect anything substantively.

As to item 95, the examiner indicated that item 95 appeared to contain several references (which he identified as items 95 and 95.a), and only the first was submitted. The first reference (item 95) should have been 2 pages, is listed in the IDS as "*Payment* and Services from PaySys" but the actual document is "*Products* and Services from PaySys."

The second reference (95.a) was identified by the examiner as "www.banktechnews.com/btn/articles/btnoct01-13.shtml internet website and printed on Sep. 12, 2003 [sic]". This reference appears to be a duplicate or misplacement of reference no. 85 in the IDS submitted June 13, 2005, more properly identified as an article by Karen Epper Hoffman, "PayPal Still Running Free," three pages, printed on 9/23/2003, with web citation of <http://www.banktechnews.com/btn/articles/btnoct01-13.shtml>.

The applicant regrets and apologizes for the mistake or misidentification, whatever may have occurred. If another copy of any reference is needed, or further clarification is needed, please contact the undersigned.

Claim Objections

The examiner indicated that claim 110 refers to an ***address book*** and lacks antecedent basis, and for purposes of examination claim 110 would be interpreted as "... each addressee in the address book ***database*** ..." Correction was required.

Claim 110 has been amended to make the required correction, and also to clarify that the information is in an ***address book record***, as set forth in claim 91. A corresponding clarifying amendment has been made to the respective independent claim 91.

Similar amendments have been made to dependent claims 127 and 145 and their respective independent claims 114 and 131.

Claim Rejections - 35 USC § 103

Claims 91–113 were rejected under 35 U.S.C. 103(a) as being unpatentable over the reference *Gardyne, Allan*, “Introducing PayPal,” 9 December 1999, downloaded from the Internet as indicated in the IDS (hereinafter *Gardyne*). *Gardyne* is merely an article summarizing certain aspects of a payment system known as “PayPal.” It is not a definitive technical article, it is a third party’s assessment of certain aspects of PayPal.

As per claim 91, the examiner asserted that *Gardyne* discloses computer implemented method(s) for providing a money transfer service between a first party and a second party through a payment enabler system, comprising the various steps of, as summarized for brevity, providing a database of registered users, maintaining an address book database, retrieving email addresses from the address book database, accessing the registered users database to determine if there is a record for a party, sending a second party a registration invitation email, conducting a user registration process, etc. The examiner admitted that *Gardyne* did not specifically refer to a default payment method and default money receiving method, but indicated it would have been obvious to one of ordinary skill in the art at the time the invention was made to include default money payment and receiving methods.

As particularly relevant to the current rejection, the examiner asserted that *Gardyne* discloses maintaining at the payment enabler system an address book database for storing address book records comprising names associated with second parties with whom a first party may initiate a money transfer, each address book record including a name and an associated email address. The examiner cited specifically to paragraph 42 of *Gardyne*: “...as long as they are not already PayPal users, and have not been referred by someone else.” (It is believed that the paragraph numbering is the handwritten numbering entered by the examiner on a copy of the reference in the record.)

This rejection is respectfully traversed. First, the cited documents relating to PayPal including the *Gardyne* reference are third-party articles that do not provide any technical details

of the operation of the PayPal system, and are not enabling as a reference. Applicant expressly objects to the reference as not enabling. Secondly, and even if the reference were enabling (which is not admitted), *Gardyne* cannot stand as a valid reference for the propositions asserted in the rejection.

It is submitted that the examiner's reliance on *Gardyne* as meeting (or even suggesting) the indicated aspects of the claims is misguided and mistaken, and should result in withdrawing the rejection of claim 91, as amended. Note closely what paragraph 42 of *Gardyne* is really saying in its totality:

“All of your friends are eligible as long as they are not already PayPal users, and have not been referred by someone else. To protect our users' privacy, we will not notify you if your friend is already a PayPal user, or has already been referred,” PayPal says. (*Gardyne*, paragraph 42).

This has absolutely nothing to do with an address book functionality! Let alone the other aspects that are part of the claimed combination! All this says is that the PayPal system will let a person pay their “friends” without necessarily notifying the person that the friend is already a PayPal user or not. But the paragraph says nothing about the process of specifying “friends.” One need not have an address book database to have specify a “friend” to whom one can send a payment. There is no teaching on this aspect.

The examiner is respectfully reminded that the email address entry aspects of the PayPal system (as reflected in other documents of record in this case, e.g. Reference V from a previous citation, see paper filed June 13, 2005) were extensively reviewed and discussed in previous papers. *Gardyne* does not supply the the missing teachings.

Looking further at the reference, *Gardyne* paragraph 20 says, “Recipients are notified by e-mail that a payment has been beamed.” *Gardyne* paragraph 18 (with emphasis supplied) says, “The only information needed to complete a transaction is the dollar amount and the *recipient's email address*. Payment recipients do not need to be registered PayPal users.” None of these provisions disclose, teach, or suggest anything about an address book database for storing address book records on behalf of a first party, as recited in claim 91 as amended.

For the examiner to conclude otherwise is impermissible hindsight and reading into the Gardyne reference that which is simply not there. The *Gardyne* reference clearly does not render these aspects of the claim obvious, as there is no disclosure, teaching, or suggestion about such an address book database, or the claimed functionality of retrieving an email address for a second party from an address book database maintained on behalf of the first party.

Nor does *Gardyne* teach anything about what the system does in the event that a selected second party is not already a registered user. In the claimed system, there is the recited step of accessing the registered users database and determining whether the retrieved email address associated with the selected particular second party has a record in the registered users database. All the reference teaches is, as stated in *Gardyne* paragraph 18, the provision of an email address but not the source of that address: “The only information needed to complete a transaction is the dollar amount and the recipient’s email address. Payment recipients do not need to be registered PayPal users.” Nothing is said as to how that email address is provided – reliance on *Gardyne* to meet the address book lookup and registered user database lookup aspects of claim 91 is also impermissible hindsight.

Finally, the examiner asserted, without reliance on any available reference, that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include default money payment and receiving methods. Again, the examiner is engaging in impermissible hindsight and reading into the reference that which is not there. Nothing is said in *Gardyne*, or in any other reference of record, about a registration process in a payment system that specifies as default money transfer method, as recited in claim 91 as amended.

As mentioned above, the examiner is respectfully reminded of the comments about the PayPal references provided in the previous paper “Amendment and Response to First Office Action in Reopened Prosecution” filed June 13, 2005. In particular, note Reference V, “Beaming Money by Email ...” Nov. 16, 1999. Paragraph 7 of this document says that, “After registering for the free service at www.paypal.com, consumers simply enter the recipient’s email address and a dollar amount. The money is debited from payor’s credit card or bank account, and credited to the recipient. ... If the recipient is not yet a PayPal user, he or she simply registers on the Paypal.com site after receiving email notification, and is immediately credited

with the amount in the new account. Funds may be withdrawn at any time by electronic transfer to a bank account or personal check from PayPal.com.” (Emphasis supplied.)

Note that the counterpart first party (“consumer”) must enter an email address, presumably into some form designed to make a payment. There is no address book. There are no details as to what information is displayed, or how this email address is “entered,” or what the PayPal system does with this entered email address – other than generally saying that an email notification is provided to the second party. *Gardyne* does not provide the missing teachings of address book, and relationship of address book entry to registered users database.

Accordingly, and for these reasons, it is submitted that claim 91, as amended, is novel and nonobvious, and the rejection should be withdrawn.

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As per claim 92, the examiner asserted that *Gardyne* discloses that the record in the registered users database includes security information provided by a first party, citing to paragraph 25 concerning security protocols.

The rejection is traversed for two reasons. First, paragraph 25 of *Gardyne* is very general as to the nature of the security information and does not specify anything about “expected security response information” as recited in the claim. Second, claim 92 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. Thus, claim 92 is therefore nonobvious and should be allowable.

As per claims 93 and 94, the examiner admitted that *Gardyne* does not specifically disclose that the security information is a question and the corresponding security response information is an expected answer, but took Official Notice that the use of security challenge questions was notoriously well known at the time the invention was made.

The rejection is traversed under the doctrine of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claims 93 and 94 are therefore nonobvious and should be allowable.

As per claim 95, the examiner asserted that *Gardyne* discloses that the transaction comprises a payment from the first party to the second party, citing paragraph 20.

The rejection is traversed under the doctrine of *In re Fine, supra*. Thus, claim 95 is therefore nonobvious and should be allowable.

As per claim 96, the examiner asserted that *Gardyne* discloses that the transaction comprises a request for a payment from the second party to the first party, citing paragraph 23, transaction types.

The rejection is traversed for two reasons. First, paragraph 23 of *Gardyne* merely says that PayPal allows detailed transaction accounting and record keeping. It discloses, teaches, and suggests nothing about requesting a payment. Second, claim 96 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 96 is therefore nonobvious and should be allowable.

As per claim 97, the examiner asserted that *Gardyne* discloses the step of, in response to determination that a second party already has an entry in the registered users database, completing the transaction, citing paragraph 20.

The rejection is traversed for two reasons. First, paragraph 20 of *Gardyne* merely says that recipients are notified by email that a payment has been beamed. It discloses, teaches, and suggests nothing about a lookup in a registered users database – *Gardyne* is sparse on technical details. Second, claim 97 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 97 is therefore nonobvious and should be allowable.

As per claim 98, the examiner asserted that *Gardyne* discloses that the registration invitation email sent to the second party by the payment enabler system includes a link that directs the second party to registration web page, citing to paragraph 20.

The rejection is traversed under the doctrine of *In re Fine, supra*. Thus, claim 98 is therefore nonobvious and should be allowable.

As per claim 99, the examiner asserted that *Gardyne* discloses that the transaction is a payment from the first party to the second party, citing to paragraph 17, payments to merchants,

business, and further obtaining authenticating information from the first party prior to sending the registration invitation email to the second party.

The rejection is traversed for two reasons. First, paragraph 17 of *Gardyne* says nothing about obtaining information from the first party prior to sending the registration invitation email. Second, claim 97 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 99 is therefore nonobvious and should be allowable.

As per claim 100, the examiner admitted that *Gardyne* does not specifically disclose that authenticating information comprises a question to be asked of the registering user and an expected answer, and cited Official Notice for the proposition of use of security challenge questions.

The rejection is traversed under the doctrine of *In re Fine, supra*. Thus, claim 100 is therefore nonobvious and should be allowable.

As per claim 102, the examiner asserted that *Gardyne* discloses that the user registration process further comprises the step of sending a registering user a confirmation email including a deep link operative for activating an account of the registering user with the payment enabler, citing to paragraph 20, linking and completing registration process.

The rejection is traversed for two reasons. First, paragraph 20 of *Gardyne* says nothing about obtaining information from the first party prior to sending the registration invitation email. Second, claim 97 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 99 is therefore nonobvious and should be allowable.

As per claims 101, 103–105, the examiner admitted that *Gardyne* does not specifically disclose steps for allowing the registering user to select a default payment method from a plurality of payment methods, and a default money receiving method from a plurality of money receiving methods, but asserted that such steps would have been obvious – without citing to any specific portions of *Gardyne*.

The rejection is traversed for three reasons. First, the examiner is again engaging in hindsight reconstruction. There is no disclosure, teaching or suggestion in *Gardyne* of such

steps, and it is improper for a blanket unsupported obviousness conclusion – it fails to make out a *prima facie* obviousness rejection. Second, such steps go far beyond the teachings or suggestions of *Gardyne*, which does not even remotely suggest selection of payment methods and money receiving methods. Third, claims 101, 103–105 are dependent claims and add further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claims should be nonobvious. Thus, claim 101, 103–105 are therefore nonobvious and should be allowable.

As per claim 106, the examiner asserted that *Gardyne* discloses storing additional information associated with a money transfer, citing to paragraph 20 in relation to transaction type information and status information.

The rejection is traversed for two reasons. First, paragraph 20 of *Gardyne* says nothing about any kind of additional information being stored, the examiner is again engaging in impermissible hindsight and reading into the reference that which is not there. Second, claim 106 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 106 is therefore nonobvious and should be allowable.

As per claim 107, the examiner asserted that *Gardyne* discloses that transaction type information is selected from send, request, refund, citing to paragraph 20 (money is sent).

The rejection is traversed for two reasons. First, paragraph 20 of *Gardyne* says nothing about any kind of transaction type information, the examiner is again engaging in impermissible hindsight and reading into the reference that which is not there. Second, claim 107 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 107 is therefore nonobvious and should be allowable.

As per claim 108, the examiner asserted that *Gardyne* discloses that status information is selected from fulfilled, cancelled, pending, citing to paragraph 23, payables and receivables.

The rejection is traversed for two reasons. First, paragraph 23 of *Gardyne* says nothing about any status information, the examiner is again engaging in impermissible hindsight and reading into the reference that which is not there. It is not reasonable to infer that payables and receivables records necessarily translate into status information as claimed. Second, claim 108 is

a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 108 is therefore nonobvious and should be allowable.

As per claim 109, the examiner asserted that *Gardyne* discloses the step of providing an account history display including information corresponding to money transfers, with an account history display, etc. citing again to paragraph 23, payables and receivables.

The rejection is traversed for two reasons. First, paragraph 23 of *Gardyne* says nothing about any kind of account history display, let alone the specific details set out in claim 109 – it merely states that the system allows transaction accounting and record-keeping. The examiner is again engaging in impermissible hindsight and reading into the reference that which is not there. Second, claim 109 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 109 is therefore nonobvious and should be allowable.

As per claim 110, the examiner admitted that *Gardyne* does not specifically disclose providing an address book display for a party to select one or more particular second parties, taking Official Notice that in email systems, the use of address books and displays are notoriously well known.

The rejection is traversed for four reasons. First, the patentable aspects of the use of the address book aspects and features were fully discussed above in connection with claim 91. Second, the examiner is again engaging in hindsight reconstruction. There is no disclosure, teaching or suggestion in *Gardyne* of any kind of address book functionality. It is improper for the examiner to arrive at a blanket unsupported obviousness conclusion – it fails to make out a *prima facie* obviousness rejection. Third, the claims steps in claim 110 go far beyond the teachings or suggestions of *Gardyne*, which does not even remotely suggest any address book functionality. Merely because such functions are known features of email programs does not necessarily make them obvious in connection with a payment system. Fourth, claim 110 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 110 therefore nonobvious and should be allowable.

As per claim 111, the examiner asserted that *Gardyne* discloses that the money transfer method comprises steps for a first money transfer from a payor to an intermediary and steps for a second money transfer from the intermediary to a payee, citing paragraph 20 (bank account).

The rejection is traversed for two reasons. First, paragraph 20 of *Gardyne* says nothing about any intermediaries and transfers, it merely states that a recipient can direct deposit to their bank account. This has nothing to do with the specific details set out in claim 111. The examiner is again engaging in impermissible hindsight. Second, claim 111 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 111 is therefore nonobvious and should be allowable.

As per claim 112, the examiner asserted that *Gardyne* discloses that the first money transfer method steps are selected from the group including deposit of an amount of cash, debiting a credit card, debiting a bank account, debiting a stored value card, etc., again citing paragraph 20 (bank account).

The rejection is traversed for three reasons. First, paragraph 20 of *Gardyne* says nothing about any specific types of money transfer steps beyond the statement that a recipient can direct deposit to their bank account. This has nothing to do with the specific details set out in claim 112 on the first money transfer side, involving an intermediary. The examiner is again engaging in impermissible hindsight. Second, there are no intermediaries beyond the recipient's bank, so the specific steps of claim 112 cannot be met or suggested. Third, claim 112 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine, supra*, the claim should be nonobvious. Thus, claim 112 is therefore nonobvious and should be allowable.

As per claim 113, the examiner asserted that *Gardyne* discloses that the second money transfer steps are selected from the group including debiting a bank account of the intermediary, dispensing cash, crediting a credit card, crediting a bank account, crediting a stored value card, etc., yet again citing to paragraph 20 (concerning bank account processing).

The rejection is traversed for three reasons. First, paragraph 20 of *Gardyne* says nothing about any specific types of money transfer steps beyond the statement that a recipient can direct deposit to their bank account. This has nothing to do with the specific details set out in claim 113 on the second money transfer side, involving an intermediary. The examiner is again

engaging in impermissible hindsight. Second, there are no intermediaries beyond the recipient's bank, so the specific steps of claim 113 cannot be met or suggested. Third, claim 113 is a dependent claim and adds further limitations to claim 91. Under the doctrine of *In re Fine*, *supra*, the claim should be nonobvious. Thus, claim 113 is therefore nonobvious and should be allowable.

For the foregoing reasons, it is submitted that claims 91–113 are novel, nonobvious, and should be allowable. It is further submitted that claims 114–148 are allowable for the same reasons as set forth above, as the same rejections and reference could have been applied by the examiner in almost exactly the same manner, and the same reasons for patentability apply.

Allowable Subject Matter

The examiner's indication that claim 109 would be allowable if rewritten in independent form to incorporate the limitations of the intervening claims is noted with appreciation.

In this regard, new independent claim 149 presents the subject matter of claim 109 in independent form together with the limitations of intervening claim 106 and claim 91. New claims 150–169 are essentially the same dependent claim set as under claim 91.

All such claims should now be allowable.

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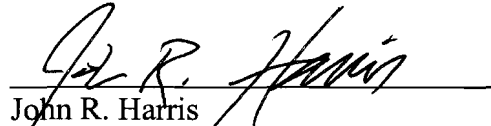
Conclusion

For the foregoing reasons, it is respectfully submitted that independent claims 91, 114, and 131, as amended, and the remaining dependent claims, have utility, are novel and non-obvious in view of the references, and should be allowable. The foregoing is presented as a full and complete response to the Office Action mailed November 1, 2006, and is believed to have placed all claims in condition for allowance. Such action is courteously solicited. If any issues remain that can be resolved by telephone, the Examiner is respectfully requested to contact the undersigned at 404-233-7000.

It is now believed that the application is in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,

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